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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/566,201

01/27/2006

Artur Pfitzner

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WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP  
TEN POST OFFICE SQUARE  
BOSTON, MA 02109

EXAMINER

KRUSE, DAVID H

ART UNIT

PAPER NUMBER

1638

MAIL DATE

DELIVERY MODE

09/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/566,201	<b>Applicant(s)</b> PFITZNER ET AL.	
	<b>Examiner</b> David H. Kruse	<b>Art Unit</b> 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-16 and 18-33 is/are pending in the application.
- 4a) Of the above claim(s) 15,16,18,19 and 29-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-14 and 20-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **STATUS OF THE APPLICATION**

1. This Office action is in response to the Amendment and Remarks filed 9 January 2008.
2. Those objections or rejections not specifically addressed in this Office action are withdrawn in view of Applicants' amendments to the claims.
3. The instant Examiner withdraws the objection of record to claims 9 and 21 in view of Applicants' response.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

5. Claims 15, 16, 18, 19 and 29-33 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 16 March 2997.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 4-14 and 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cade et al (PGPPUB US-2004/0154051, published 5 August 2004,

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filed 12 March 2004) in view of Sato, S., (2000) DNA Res. 7 (2), 131-135 and in further view of Cade *et al* (U.S. Patent 6,706,942, filed 8 December 2000).

The teachings of Cade *et al* (2004) and Sato (2000) can be found in the previous Office action.

Cade *et al* (2000) teach an isolated nucleic acid comprising a genomic copy of NI16 (claim 4-1) containing 3.1 kb of sequence upstream of NI16 and the coding region of NI16 at column 17, Example 3. Cade *et al* (2000) teach 5' upstream sequence of the NI16 gene at SEQ ID NO: 3 (see column 18, 1<sup>st</sup> paragraph) comprising nucleotides 390-1225 of instant SEQ ID NO: 2, and that SEQ ID NO: 3 comprises a salicylic acid responsive element at nucleotides 646-665. Cade *et al* (2000) teach that the NI16 gene is induced by salicylic acid at column 17, Example 2.

The difference between the instant claims and the teachings of the prior art is the explicit teaching of instant SEQ ID NO: 2, or a recombinant nucleic acid containing a transgene and a first nucleic acid sequence containing SEQ ID NO: 2.

Cade *et al* (2004) teaches that the promoter of SEQ ID NO: 24 (comprising nucleotides 290-1226 of instant SEQ ID NO: 2) is inducible by salicylic acid at Tables 4 and 5 on page 22.

Given the fact that Sato had taught a recombinant nucleic acid containing instant SEQ ID NO: 2, and Cade *et al* (2004) had taught a 962 bp fragment having inducible promoter activity, it would have been *prima facie* obvious to one of ordinary skill in the instant art to modify the teachings of Cade *et al* (2004) to use a larger 5' region. Given

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the success of Cade *et al* (2004), one of ordinary skill in the instant art would have had a reasonable expectation of success in making the instantly claimed invention.

Applicants argue that Cade provides genomic sequences but, as discussed for Sato above, Cade fails to disclose a nucleic acid containing at least a first nucleotide sequence containing SEQ. ID. No. 2 being operably linked to at least a second nucleotide sequence containing a transgene as defined in present claim 1. Applicants argue that Cade merely discloses nucleotide sequences obtained by sequencing fragments of the genome of *Arabidopsis thaliana*, but not a nucleic acid containing a transgene. Applicants argue that since Cade fails to teach, even inherently, every limitation of the instant claims, Cade does not anticipate the claims. Applicants argue that since Cade fails to disclose or suggest the function of SEQ ID NO: 2 as a promoter and fails to disclose or suggest the superior properties of SEQ ID NO: 2 for use as a regulatory sequence to drive the expression of a transgene, as discussed above for Sato, Cade also cannot render the claims obvious (page 13 of the Remarks). These arguments are not found to be persuasive for the reasons outlined above. Cade had taught that a fragment of SEQ ID NO: 2 was a salicylic acid inducible promoter. Cade also had taught a chimeric gene comprising said promoter operably lined to a coding sequence of interest, a vector comprising said chimeric gene and a transgenic plant host cell comprising said chimeric gene at claims 16-21 (Cade 2004).

### **Conclusion**

8. No claims are allowed.
9. This Office action is non-final in view of the new grounds of rejection.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (571) 272-0799. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at (571) 272-0975. The central FAX number for official correspondence is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-1600.

/David H Kruse/  
Primary Examiner, Art Unit 1638  
23 September 2008